

REMARKS/ARGUMENTS

Amendments

Before this Amendment, claims 1-41 and 43-45 were present for examination. No claims are amended, added or canceled. Therefore, claims 1-41 and 43-45 are present for examination, and claims 1, 15, and 29 are the independent claims. No new matter is added by these amendments. Applicants respectfully request reconsideration of this application as amended.

The Office Action dated May 3, 2006 ("Office Action") rejected claims 1-41 and 43-45 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. The Office Action also rejected claims 1-41 and 43-45 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Patent No. WO/01/19005 A1 ("WO Rabenko") in view of the cited portions of U.S. Publication No. 2002/0129154 to Okawa, et al. ("Okawa") and further in view of the cited portions of U.S. Patent No. 6,580,710 to Bowen et al. ("Bowen"). The Examiner, however, states that cited portions of U.S. Patent 6,819,682 to Rabenko et al. ("Rabenko") are identical to the reference, and the Rabenko column and line number are used for ease of reference. Applicants will also refer to Rabenko in this Amendment.

35 U.S.C. §112, First Paragraph

The Office Action rejected the pending claims under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Since there was no previous §112, first rejection, Applicants assume that the basis for the rejection is the previous Amendment, dated April 6, 2006.

In that Amendment, the claims were amended to generally provide for:

a processor programmed to ... convert one of the ... [received] signals comprising digitally formatted video information into separate signals, the separate signals including:
a first signal comprising the digitally formatted video information
converted to a first digital video format; and
a second signal comprising the digitally formatted video
information converted to a second digital video format.

Applicants note that this concept is fully supported in the application as filed. More specifically, attention is directed to page 46, lines 27-30, which set forth a "processing device (for instance, a digital signal processor) operable to decode a signal encoded by a remote transmission algorithm, **producing digitally-formatted video information**, for instance, **MPEG2 data and/or HDTV signals**" (emphasis added). Withdrawal of this rejection is respectfully requested.

35 U.S.C. §103(a), Rabenko, Okawa, Bowen

Missing Elements: The Office Action rejected claims 1-41 and 43-45 under 35 U.S.C. §103(a) as being unpatentable over Rabenko in view of Okawa, and further in view of Bowen. To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP § 2143. Applicants believe significant limitations from the independent claims are neither taught nor suggested in the references.

More specifically, none of the references cited above can be relied upon, either alone or in combination, to teach or suggest a NID configured to convert a signal comprising digitally formatted video information into *two different digital video formats* for distribution to separate internal interfaces, as recited in independent claim 1. Similar limitations are found in independent claims 15 and 29, as amended.

The Office concedes that Rabenko fails to teach converting a signal "into separate signals with a first and second digital video format, respectively" (Office Action, p. 4. ll. 18-20). Instead, the Office relies on Okawa to teach this limitation (*Id.*, p. 5, ll. 3-7). The Office states that the "router ... converts video signals to an MPEG digital format that corresponds to the first digital video format" (*Id.*, p. 5, ll. 3-4).

But this clearly differs from the claims. For example, independent claim 1 recites a processor configured to convert a received signal to separate signals - i.e., a *first signal* comprising the digitally formatted video information is converted to a *first digital video format* and a *second signal* comprising the digitally formatted video information converted to a *second digital video format*. There is no suggestion in Okawa that the router convert an incoming digital video signal to different signals comprising different digital video formats. Fig. 1 of

Okawa illustrates that the received analog signal is converted only into MPEG by the encoder. There is no apparent suggestion that the encoder convert received *digitally formatted data*, nor any suggestion that it convert a signal to a *second digital video format* (Okawa, p. 2, ¶[0022], [0029]; Fig. 1).

Combination: Moreover, there is no suggestion in the references to modify the teachings of Rabenko to include Bowen and Okawa. Rabenko is directed at the synchronization of timing information in a cable modem network. Bowen is instead directed at intra-premises voice and data distribution using in place POTS telephone lines; while Okawa is directed at a router which controls the analog output of a VCR and converts that output into MPEG. These patents cover very diverse areas, and it is unclear what would motivate one skilled in the art to combine their teachings.

The basic test for establishing obviousness requires that to "establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art, not in the applicant's disclosure." MPEP § 2143.

The Office instead relies upon the following contentions:

First, the Office offers the Rabenko-Okawa combination because the "arrangement permits viewing of video content on PCs without the expense of a special network and special interfaces" (Office Action, p. 5, ll. 6-9). It is unclear what this has to do with converting a received signal to two separate signals, each comprising a different digital video format.

Second, the Office offers the Rabenko-Bowen combination based on the contention that the "arrangement provides broadband services to the customer without the expense and inconvenience of installing new network wiring" (Office Action, p. 5, ll. 17-19). But this showing is insufficient. Unless the art itself "suggests the desirability of the combination," benefits alone are clearly not enough. MPEP § 2143.1. Conclusory statements of

generalized advantages of a combination are not sufficient to support a finding of motivation.
See In re Beasley, 2004 WL 2793170 (Fed. Cir. 2004).

In light of the foregoing, Applicants respectfully submit that the specified limitations in independent claims 1, 15, and 29 are allowable for at least the foregoing reasons. Claims 2-14, 16-28, 30-41 and 43-45 each depend from these independent claims, and are believed allowable for at least the same reasons as given above. Applicant respectfully requests that the rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


Michael L. Drapkin
Reg. No. 55,127

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
MLD:klb
60776727 v1